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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No. 9368

Application of

Hornig Jaan Lin et al.

Serial No. 10/014,469

Group Art Unit: 3627

Filed: December 14, 2001

Examiner: Rudy, A.

For: **PERSONAL DATA MINING ON THE WEB**

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATION OF FACSIMILE TRANSMISSION

Sir:

I hereby certify that the following papers are being
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Fee Transmittal Sheet - 1 page

Petition - 9 pages

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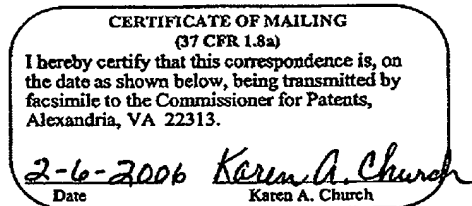
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Sir:

Transmitted herewith for filing is a Petition.

 X Please charge any fees due to the account of NCR Corporation,
Deposit Account No. 14-0225.

Our telephone number is: (937) 445-2990.

Respectfully,

Paul W. Martin
Reg. No. 34870
Attorney for: Horng Jaan Lin et al.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Attorney Docket No. 9368

PETITION TO THE
COMMISSIONER
UNDER 37 CFR 1.181

Application of:

Hornng Jaan Lin et al.

Art Unit: 3627

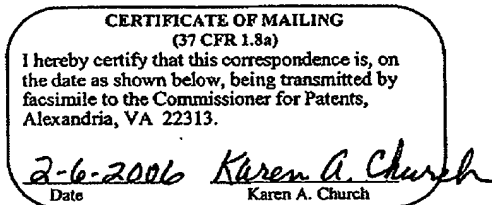
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PETITION

Sir:

Petitioners, by their Attorney, respectfully request
that the Restriction Requirement mailed on February 23,
2005, be withdrawn as inappropriate.

STATEMENT OF FACTS

One way of characterizing the invention is identified
in paragraph 018 of the Specification, page 4: "The web
butler includes web mining functionality and is attached to
an individual's web browser. As the individual browses the

web and makes purchases, the web mining application learns the individuals web usage patterns, e.g. web sites browsed, web sites where purchases are made, and items purchased. As the web butler analyzes and learns the individual's habits on the web, it starts offering services increasing productivity for the individual, e.g. handling travel plans, purchasing groceries, and paying bills."

The present application as originally filed contained claims 1-17. Claims 1-9 were directed to, "a computer-implemented method of performing data mining on an individual basis", claim 1 being the only independent claim. Claims 10-17 were directed to, "a computer system for performing data mining on an individual basis".

In the restriction requirement of February 23, 2005, the Examiner required restriction into two groups. Group I contained claims 1-9. Group II contained claims 10-17. The Examiner's basis for restriction was the statement that claims 1-9 may be performed by hand.

On March 23, 2005, Applicants responded to the restriction requirement of February 23, 2005, with an amendment of claims 1 and 3 to include the phrase, "by a computer" after each step, in order to further emphasize

that the steps of claims 1-8 were performed by a computer, not by hand. Applicants failed to make an election and requested reconsideration of the restriction requirement.

On June 9, 2005, the Examiner mailed the restriction requirement a second time.

On July 11, 2005, Applicants responded with an election of claims 1-8, with traverse. Applicants emphasized that a computer-implemented invention cannot be performed by hand and asked for reconsideration of the restriction requirement.

On September 20, 2005, the Examiner mailed an Office Action. In the Office Action, the Examiner made final the restriction requirement, the Examiner stating that, "the word 'by' does not require a computer to process the monitoring". The Examiner further issued a rejection under 35 USC 101 for non-statutory subject matter for the same reason (relief for which is not the subject of this Petition).

Claims 4, 5, and 9 are currently cancelled as of the submission of this Petition. Claims 1-3 and 6-8 are

presented in Appendix A as they were first amended on March 23, 2005.

ARGUMENT

MPEP 2106 states that "computer-related inventions" include inventions implemented in a computer. By including the phrase, "computer-implemented", in the preamble of independent claim 1, Applicants expressly limited the invention to being "computer-related". Therefore, all steps are performed by the computer.

Applicants amended the steps to expressly include the language, "by a computer". Such amendment was made in order to further emphasize that none of the steps could be interpreted so broadly as to be capable of being performed by hand.

With respect to claim 1,

the step of "monitoring" an individual's use patterns "by a computer" expressly limits the "monitoring" to being completed by a computer,

the step of "creating" an individual profile data ... "by the computer" expressly limits the "creating" to being completed by a computer, and

the step of "performing" tasks automatically ... "by the computer" expressly limits the "performing" to being completed by a computer.

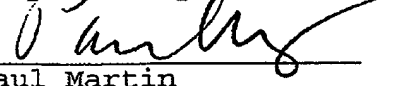
With respect to claim 3,

the step of "analyzing" the individual's use patterns "by the computer" expressly limits the "analyzing" to being completed by a computer.

CONCLUSION

Wherefore, Petitioners respectfully request that the restriction requirement be withdrawn.

Respectfully submitted,


Paul Martin
Attorney for Applicants
(937) 445-2990

Dayton, OH

FEB - 6 2006

Appendix A

1. A computer-implemented method of performing data mining on an individual basis comprising:

monitoring an individual's use patterns by a computer;
creating an individual profile data based on said monitoring by the computer; and

performing tasks automatically in accordance with an individual's request and based on the individual profile data by the computer.

2. The method as claimed in claim 1 wherein the request includes at least one of grocery shopping, travel planning, and financial transactions.

3. The method as claimed in claim 1 comprising analyzing the individual's use patterns by the computer.

4-5. (Cancelled).

6. The method as claimed in claim 1 wherein the individual profile data includes individual specific characteristics.

7. The method as claimed in claim 6 wherein the individual-specific characteristics include at least one of physical characteristics, financial characteristics, and identifying characteristics.

8. The method as claimed in claim 1 wherein the individual profile data includes at least one of shopping preferences, browsing preferences, financial preferences, and travel preferences.

9. (Cancelled).

10. A computer system for performing data mining on an individual basis comprising:

a processor for receiving and transmitting data; and
a memory coupled to said processor, said memory having stored therein a sequences of instructions which, when executed by one of said one or more processors, cause one of said processor to monitor an individual's use patterns; create an individual profile data based on said monitoring; and perform tasks automatically in accordance with an individual's request and based on the individual data profile.

11. The computer system as claimed in claim 10 wherein said memory further comprises sequences of instructions which, when executed by one of said processor, cause said processor to analyze the individual's use pattern.

12. The computer system as claimed in claim 10 wherein the individual's use patterns include the individual's web use.

13. The computer system as claimed in claim 10 wherein the individual profile data includes at least one of shopping preferences, browsing preferences, financial preferences, and travel preferences.

14. The computer system as claimed in claim 10, wherein the request includes at least one of grocery shopping, travel planning, and financial transactions.

15. The computer system as claimed in claim 12 wherein the web use includes at least one of web browsing, web searching, and web shopping.

16. The computer system as claimed in claim 10 wherein the individual profile data includes individual specific characteristics.

17. The computer system as claimed in claim 16 wherein the individual-specific characteristics include at least one of physical characteristics, financial characteristics, and identifying characteristics.